

Applicant's arguments in her Request for Reconsideration filed on July 2, 2002, claims 1-6 and 13-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tessler* in view of the *Abstract of Japanese Patent Publication No. 410075809A* (hereinafter “*Abstract of JP '809*”), and claims 7-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tessler* in view of *Abstract of JP '809* and *Kirshbaum*.

Referring to Paragraph No. 4 of the Office Action in which claims 2 and 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, and Paragraph No. 8 of the Office Action in which it states that the 35 U.S.C. § 112, second paragraph, rejection of claims 2 and 8 made in the Office Action mailed on April 2, 2002 has been withdrawn in view of Applicant's argument in the Request for Consideration filed on July 2, 2002, Applicant respectfully submits that it is unclear whether claims 2 and 8 are or are not being rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

However, to reduce the issues, claims 2 and 8 have been amended. More particularly, dependent claims 2 and 8 have been amended to more positively recite that a first central axis which connects a center of a bottom surface of the first ditch portion and a center of curvature of both an outer surface of the ring and an inner surface of the ring and a second central axis which connects a center of a bottom surface of the second ditch portion or portions and the center of curvature of both the outer and inner surfaces of the ring, wherein the first central axis is separated from the second central axis by an angle of approximately 180 degrees in order for the first ditch portion and the second ditch portion or portions to be arranged so that when the ring is put on any finger of a hand of a wearer of the ring except a thumb and a little finger thereof in such a manner that the outer surface of the first stone is on a back of the hand of the wearer of the ring, the outer surface of the second stone is on a palm side of the hand of the wearer of the ring and not seen from the back of the hand of the wearer of the

ring, and that when the ring is put on the any finger of the hand of the wearer of the ring except the thumb and the little finger thereof in such a manner that the outer surface of the second stone is on the back of the hand of the wearer of the ring, the outer surface of the first stone is on the palm side and not seen from the back of the hand of the wearer of the ring.

It is believed the amendments to claims 2 and 8 now add positive structural limitations so that claims 2 and 8 are no longer indefinite. Support for the amendments to claims 2 and 8 can be found on page 4, line 22 through page 5, line 7. Based on the foregoing, Applicant respectfully requests withdrawal of the rejection of claims 2 and 8 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Applicant respectfully traverses the rejection of claims 1-6 and 13-15 under 35 U.S.C. § 103(a) as being unpatentable over *Tessler* in view of *Abstract of JP '809*, and the rejection of claims 7-12 under 35 U.S.C. § 103(a) as being unpatentable over *Tessler* in view of *Abstract of JP '809* and *Kirshbaum*.

As a quick synopsis of the applied prior art references, Applicant hereby repeats the abstracts of *Tessler* and *Abstract of JP '809*, and the first claim of *Kirshbaum*, as follows:

Tessler discloses jewelry which includes a body of jewelry material, a plurality of relatively large gems and a plurality of relatively small gems, and a gem mounting on the body of jewelry material mounting the gem serially, non-overlapped and alternating individual relatively large and relatively small gems and mounting the relatively large gems at a higher level than the relatively small gems. A method includes the steps of providing a body of jewelry material, providing a first plurality of relatively large gems and a second plurality of relatively small gems, mounting the gems on the body of jewelry material serially, non-overlapping and alternating relatively large and relatively small gems and

mounting the first plurality of relatively large gems at a higher level than the second plurality of relatively small gems.

The *Abstract of JP '809* discloses a ring (R) which is made up of a ring section (1) and hard ornaments (2, 3) provided opposite each other with respect to a center thereof. The material and color of the ring section (1) are similar to those of existing rings and are optional. The ring section (1) can be completely circular and of a fixed size or adjustable size. The hard ornaments (2, 3) are of optional material, shape, color, and size, including jewels, ambers, or pearls, and are attached to the ring section (1). At least one of the hard ornaments (2, 3) is a lumpish object which is attached in a manner protruding outwardly from the ring section (1). Then, the two ornaments (2, 3), which are attached to one ring, are made up of jewels which are different at least in either of material, shape, color, and size, and are contrastively beautiful in appearance. The *Abstract of JP '809* discloses that the problem to be solved by the ring is to "appreciate the appearance and beauty of two ornaments with one ring by providing hard ornaments on opposite sides with respect to the center of the ring section and making one ornament a lumpish object protruding in the opposite side from the center of the ring section." (Emphasis added).

Kirshbaum discloses a pair of finger rings which include a first ring having an outer surface portion containing projecting indicia means extending generally perpendicular thereto, and a second ring having a corresponding outer surface portion containing intaglio indicia means, the projecting and intaglio indicia means being constructed to mate with one another upon engagement of the surface portions.

On page 3, lines 19-20, the Office Action indicates that *Tessler* discloses a band with a ditch portion and a stone, but lacks a stone fixed on opposite sides of the ring, and that the *Abstract of JP '809* discloses a ring with stones affixed on opposite sides of the ring. On

page 3, line 20 through page 4, line 3, the Office Action concludes that “It would have been obvious to a person having ordinary skill in the art at the time of applicant’s invention to modify the ring to have a ditch portion and stone on opposite sides of the ring in view of *JP ‘809* in order to provide a more interesting ring.”

Applicant respectfully submits that one of ordinary skill in the art would not be motivated to modify *Tessler* in view of the *Abstract of JP ‘809* in the manner suggested by the Office Action for the following reasons. In FIG. 1, *Tessler* clearly shows that his ring (10) has a cross-section that is thicker and wider at the top of the ring (10) in order to accommodate the relatively large longitudinally extending groove 20 which houses both large gems (12, 13, 14) and small gems (16, 18). On the other hand, the bottom of the ring (10) is thinner in cross-section in order for the ring to be comfortably worn by the user and because *Tessler* never contemplated putting ditch portions in the bottom portion of the ring. Because of the specific design of the band portion of the ring wherein the top portion is wider and the bottom portion is narrowed, it is clear that the longitudinally extending groove (20) shown in the top of the ring (10) could not be placed in the bottom of the ring (10) because it is too large in width, depth, and length to be accommodated in the narrowed cross-section of the bottom of the ring (10). Therefore, Applicant respectfully submits that one of ordinary skill in the art would not be motivated to modify the ring of *Tessler* with either the disclosure of the *Abstract of JP ‘809* alone or the disclosure of the *Abstract of JP ‘809* together with *Kirshbaum* to place the ditch portions in the bottom of the ring (10) of *Tessler* because the placement of such ditch portions in the bottom of the ring (10) of *Tessler* would make the ring (10) of *Tessler* unsuitable for its intended purpose (i.e., the band would be weakened and more susceptible to breakage or wearing through of the band on the bottom side of the ring).

In addition, even assuming arguendo that one of ordinary skill in the art would be motivated to place a ditch portion in the bottom portion of the ring (10) shown in FIG. 1 of *Tessler*, the bottom portion of the ring (10) could not have a deep enough ditch portion made therein in order to accommodate either the large or small gems (12, 13, 14, 16, 18) of *Tessler* or the hard ornaments (2, 3) of the *Abstract of JP '809* so that a top surface of the gems or hard ornaments were housed below the outer surface of the band portion of the ring (10) as is specifically called for by the claim language of independent claim 1 (i.e., an exposed outer surface of the first and second stones does not jut from the first and second ditch portion, respectively).

Further, Applicant respectfully disagrees with the Office Action's characterization that if one of ordinary skill in the art were to modify the ring disclosed in *Tessler* by the disclosure of the *Abstract of JP '809*, a ring having ditch portions in opposing sides of the outer surface of the ring would result. Rather, Applicant respectfully submits that one of ordinary skill in the art can only modify a primary reference by the structure existing in the secondary reference and not by the mere idea of placing stones on opposite sides of a ring. Therefore, Applicant respectfully submits that if one of ordinary skill in the art would even consider modifying the ring of *Tessler* by the disclosure of the *Abstract of JP '809* which the Applicant is not admitting that one of ordinary skill in the art would, the ring that would result would not have ditch portions in opposite side thereof with stones or gems mounted in the ditch portions, but instead would be the ring shown in FIG. 1 of *Tessler* with either the hard ornament (2, 3) of the *Abstract of JP '809* situated in its prong or tine mounted on the bottom portion of the band of the ring (10) shown in FIG. 1 of *Tessler* in opposition to the location where the longitudinally extending groove (20) is mounted on the top portion of the ring (10). In other words, the disclosure of the *Abstract of JP '809* does not offer any

incentive to recess the hard ornament therein and therefore, if one of ordinary skill in the art were to modify the ring (10) of *Tessler* shown in FIG. 1 by the disclosure of the *Abstract of JP '809*, the ordinary skilled artisan would not arrive at a ring having ditch portions on opposing sides with gems or stones mounted therein as is the disclosed with respect to the present invention.

On page 4, lines 3-7, the Office Action states that “In regards to the specific stones claimed, it would have been obvious to one having ordinary skill in the art at the time of applicant’s invention to use any of the stones claimed, since the examiner takes Official Notice of the use of diamonds, sapphires, rubies, and emeralds in jewelry and the selection of any of these known stones to use would be within the level of ordinary skill in the art.”

Applicant respectfully traverses the Office Action’s use of Official Notice and respectfully request that a reference be produced which shows, as is recited in independent claim 13, “a first stone fitted into said first ditch portion; and a second stone which differs in material from said first stone and is fitted into said second ditch portion,” wherein the first and second ditch portions have been previously defined in the claim to be formed in first and second portions of the ring from an outer surface toward an inside of the first and second portion, respectively. Although Applicant does not contest that it is common to use diamonds and any one of rubies, emeralds, or sapphires together in a ring, Applicant respectfully submits that nothing in *Tessler* and nothing in the *Abstract of JP '809* would motivate one of ordinary skill in the art to place a diamond in a ditch portion on one side of a ring and another gem, such as a ruby, an emerald, or a sapphire, in a ditch portion on an opposing side of a ring so that one viewing the ring worn on the hand of the wearer can only see one of the stones/gems at a time. There is no disclosure in *Tessler* that would motivate one of ordinary skill in the art to place a diamond in a ditch portion on a top side of the ring

and a ruby or an emerald or a sapphire in a ditch portion on the opposed bottom side of the ring as is done in the present invention.

In addition to the above-discussed arguments, Applicant respectfully submits that objectives of *Tessler* and the *Abstract of JP '809* are much different than the objective of the ring of the present invention. More particularly, *Tessler* continually states in his "Background of the Invention" section in col. 1, line 8 through col. 2, line 48, that his objective in creating the ring of his invention was to mount a plurality of relatively large and small gems in a manner so that the top surface of the relatively large gems is mounted at a higher elevation than the top surface of the relatively small gems. On the other hand, the *Abstract of JP '809* discloses a ring in which the hard ornaments attached thereto were purposely to be mounted so as to protrude from the band portion thereof so that one would appreciate the beauty of the hard ornaments, and so that the protruding hard ornaments would create an accupressure effect on the palm of the wearer of the ring for health improvement reasons and to give the wearer reassurance that the hard ornament is still on the ring and had not accidentally become dislodged from the tine or prong. From reading and viewing *Tessler* and the *Abstract of JP '809*, one of ordinary skill in the art would never have been motivated to come up with the ring of the present invention because the objective thereof are so different from the objective of the present invention (i.e., to create one ring with a stone or gem recessed on one side of the band and a second stone or gem, different from the first stone or gem, recessed on an opposing side of the band of the ring, to in effect create the appearance of two different rings depending upon the orientation in which the wearer wears the ring).

Additionally, the Office Action states that it would have been obvious to modify the ring disclosed in *Tessler* to have a ditch portion and stone on an opposite side in view of the

Abstract of JP '809. However, Applicant respectfully submits that this argument has a fundamental error. That is, the ring disclosed and suggested in the *Abstract of JP '809* does not provide any ditch portion beneath the surface of the ring section (1), nor does it suggest any stone fitted in such a ditch portion.

The *Abstract of JP '809* which is relied upon in the outstanding Office Action is basically a translation of paragraph no. [0009] of its corresponding *Japanese Patent Application Laid-Open No. JP 10(1998)-75809* and Applicant respectfully submits that the *Abstract of JP '809* is not a full and correct rendition of paragraph no. [0009]. Thus, we have attached a translation of paragraph nos. [0009] and [0002] of *Japanese Patent Application Laid-Open No. JP 10(1998)-75809* (see Attachment 1 attached to this Amendment).

Paragraph no. [0009] states that hard ornaments (2, 3) of a ring illustrated in FIG. 1 are attached to the ring section (1) in a manner employed in known arts. The known arts mentioned here should correspond to conventional art described in paragraph no. [0002]. Further, paragraph no. [0009] describes that when ornaments are pearls or jewels of a relatively large size, they are provided at one part on the circumference of the ring section in a manner of protruding in the opposite side from the center of the ring section. Thus, ornaments such as pearls and jewels of a relatively large size are fixed by being set on the circumference of the ring section. This method is different from forming some ditch portions from an outer surface toward an inside of a ring and fitting ornaments into the ditch portions. Based on the disclosure of paragraph no. [0009] and paragraph no. [0002] as to how to attach hard ornaments (2, 3), the ring of FIG. 1 of *JP '809* illustrates that both hard ornaments (2, 3) are set on the circumference of the ring section (1). Therefore, the ring of FIG. 1 does not illustrate any ditch portion recessed beneath the outer surface of the ring section (1), nor does it disclose the existence of it at all. Consequently, the ring in FIG. 1 of *JP '809* fails to

disclose or suggest “a first stone fitted into said first ditch portion; a second stone fitted into said second ditch portion,” as is recited in independent claim 13 of the present invention.

Tessler fails to provide a structure comprising “a ditch portion” and “at least one stone fitted into the ditch portion” at a band bottom portion, and furthermore, such a structure is physically impossible to implement in *Tessler*. In other words, applying an idea or creation to provide such a structure to the thin and narrow band bottom portion of the ring of *Tessler* would result in destroying the ring.

As stated above, *JP 10(1998)-75809* fails to provide a structure comprising “a ditch portion” and “at least one stone fitted into the ditch portion.” Therefore, applying the teachings of *JP 10(1998)-75809* to the ring disclosed in *Tessler* will never result in creating the ring having a ditch portion and a stone fitted into the ditch portion on the opposite side of the ring.

With respect to the rejection of claims 7-12 under 35 U.S.C. § 103(a) as being unpatentable over *Tessler* in view of the *Abstract of JP '809* and *Kirshbaum*, Applicant respectfully submits that one of ordinary skill in the art would never be motivated to combine the three cited references absent the impermissible hindsight teachings of the present application. Applicant has already pointed out above that because of the narrowed bottom section of the band of the ring (10) of FIG. 1 of *Tessler*, one of ordinary skill in the art would never be motivated to place a ditch portion therein because such would make the bottom portion of the ring section weak and susceptible to failure or wear through, and also that the *Abstract of JP '809* does not specifically disclose the structure of a ditch portion which could be used to modify *Tessler*. Although *Kirshbaum* does disclose ditch portions which are shaped so as to form indicia such a person's name, one of ordinary skill in the art would not be motivated to form the ditch portion shaped as indicia in the bottom portion of the ring (10)

of *Tessler* as modified by the *Abstract of JP '809* for the same reason that the indicia shaped ditch portions would weaken the integrity of the band so that it would be susceptible to failure such as caving in, or sheering through, or wear.

It should be noted that, even if the ring disclosed in *Tessler* could be modified based upon the teachings of *JP 10(1998)-75809* as discussed above, the modified ring would have a protruding lumpish stone supported by a mount directly set on an outer surface of its thin and narrow band bottom portion. Assuming that the teachings of *Kirshbaum* are applied to the modified ring of *Tessler*, the reasonably possible modification would be only replacing the above-mentioned protruding lumpish stone supported by a mount with projecting indicia (13, 16). Therefore, the Office Action's assertion that applying the three cited references would lead to the subject matter of claim 7 of the present invention is an unjustification based upon an afterthought and it is rendered the Office Action's conclusions are unreasonable and illogical.

Applicant respectfully submits that claims 2-6 are either directly or indirectly dependent upon claim 1 so that arguments serving to patentably distinguish claim 1 from the prior art of record are available, among others, to patentably distinguish claims 2-6.

Applicant also respectfully submits that claims 8-12 are all directly dependent upon claim 7 so that arguments serving to patentably distinguish claim 7 from the prior art of record are available, among others, to patentably distinguish claims 8-12. Applicant also respectfully submits that claims 14 and 15 are either directly or indirectly dependent upon claim 13 so that arguments serving to patentably distinguish claim 13 from the prior art of record are available, among others, to patentably distinguish claims 14 and 15. Based on the foregoing, Applicant respectfully requests withdrawal of all of the rejections of the claims under 35

U.S.C. § 103(a) based on any combination of *Tessler*, the *Abstract of JP '806*, and *Kirshbaum*, and allowance of claims 1-15.

New claims 16-19 have been added to claim the invention in varying scope. More particularly, new claims 16 and 17 are independent claims either directly or indirectly dependent upon independent claim 1. New claim 18 is a dependent claim directly dependent upon independent claim 7. New claim 19 is a dependent claim directly dependent upon claim 13. Applicant respectfully submits that in the structure of the ring disclosed in *Tessler*, it is necessary to provide a plurality of jewels of different sizes below the top surface. In contrast, dependent claims 16-19 of the present invention do not require such a structure at all and therefore, Applicant respectfully submits that *Tessler* cannot be relied upon as a basis for rejecting dependent claims 16-19.

Applicant respectfully submits that new claims 16-19 do not add new matter. Applicant also respectfully submits new claims 16 and 17 are either directly or indirectly dependent upon claim 1 so that arguments serving to patentably distinguish claim 1 from the prior art of record are available, among others, to patentably distinguish new claims 16 and 17. Applicant also respectfully submits new claim 18 is directly dependent upon claim 7 so that arguments serving to patentably distinguish claim 7 from the prior art of record are available, among others, to patentably distinguish new claim 18. Applicant also respectfully submits new claim 19 is directly dependent upon claim 13 so that arguments serving to patentably distinguish claim 13 from the prior art of record are available, among others, to patentably distinguish new claim 19. Based on the foregoing, Applicant respectfully requests allowance of new claims 16-19.

In view of the present amendment, amended claims 1-15 are believed to be in condition for allowance, and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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IN THE CLAIMS:

Please amend dependent claims 2 and 8, as follows:

2. (Amended) The ring according to claim 1, further comprising:
a first central axis which connects a center of a bottom surface of said first ditch portion
and a center of curvature of both and outer surface of said ring and an inner surface of said ring;
a second central axis which connects a center of a bottom surface of said second ditch
portion and said center of curvature of both said outer and inner surfaces of said ring, wherein
said first central axis is separated from said second central axis by an angle of approximately 180
degrees in order for said first ditch portion and said second ditch portion [are so] to be arranged
so that when said ring is put on any [of the fingers excluding the] finger of a hand of a wearer
of said ring except a thumb and [the] a little finger thereof in such a manner that said outer
surface of said first stone is on [the] a back of [the] said hand of said wearer of said ring, said
outer surface of said second stone is on [the] a palm side of said hand of said wearer of said ring
and not seen from [the] said back of said hand of said wearer of said ring, and that when said ring
is put on said any [of the fingers] finger of said hand of said wearer of said ring except said
thumb and said little finger thereof in such a manner that said outer surface of said second stone
is on [the] said back of said hand of said wearer of said ring, said outer surface of said first stone
is on said palm side and not seen from said back of [the] said hand of said wearer of said ring.

8. (Amended) The ring according to claim 7, further comprising:

a first central axis which connects a center of a bottom surface of said first ditch portion
and a center of curvature of both and outer surface of said ring and an inner surface of said ring;
a second central axis which connects a center of a bottom surface of said plurality of
second ditch portions and said center of curvature of both said outer and inner surfaces of said
ring, wherein said first central axis is separated from said second central axis by an angle of
approximately 180 degrees in order for said first ditch portion and said plurality of second ditch
portions [are so] to be arranged so that when said ring is put on any [of the fingers excluding the]
finger of a hand of a wearer of said ring except a thumb and [the] a little finger thereof in such
a manner that said outer surface of said stone is on [the] a back of [the] said hand of said wearer
of said ring, said initials are on [the] a palm side and not seen from [the] said back of [the] said
hand of said wearer of said ring, and that when said ring is put on [said] any of [the fingers]
finger of a hand of a wearer of said ring except said thumb and said little finger thereof in such
a manner that said initials are on said back of [the] said hand of said wearer of said ring, said
outer surface of said stone is on said palm side and not seen from said back of [the] said hand
of said wearer of said ring.

16-19. (New).

[0002]

【Description of the Conventional Art】 A ring comprising a conventional ring section having hard ornaments such as diamond and pearl, if ornaments are diamonds of a small size and arranged on the circumference of the ring section with spaces therebetween, is 5 hereinafter referred to as a crown type. And a ring comprising a conventional ring section having hard ornaments such as diamond and pearl, if ornaments are pearls or jewels of a relatively large size and provided at one part on the circumference of the ring section in a manner of protruding in the opposite side from the center of the ring section, is hereinafter referred to as one-point type. When wearing a crown type ring, it does not 10 matter which of the ornaments arranged on the ring section appears on the palm side or the back side of the palm. In contrast, when wearing a one-point type ring, usually a wearer wears the ring in a manner the ornament naturally appears on the back side of the palm.

15 [0009] Fig. 1 is an oblique view of one example of the ring according to the present invention. A ring R comprises a ring section 1 and hard ornaments 2, 3 provided on opposite sides to each other with respect to the center of the ring section. The material, color and the like of the ring section 1 are similar to those of existing rings and are optional. The ring section 1 can be completely circular and of a fixed size or adjustable 20 size. The hard ornaments 2, 3 are of optional material, shape, color and size, including jewels of various kinds, ambers or pearls, attached to the ring section 1 in a manner employed in the conventional art, and at least one is a lumpish object and attached in a manner of protruding outward from the ring section 1.